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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,955	02/09/2004	Colleen Zielske	03211	1658

20879 7590 03/13/2006

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EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/775,955

Applicant(s)

ZIELSKE, COLLEEN

Examiner

Nasser Ahmad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 16-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Rejections Withdrawn***

1. Claims 10-13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Colon (4331576) made in the last Office Action has been withdrawn in view of the amendment filed on December 16, 2005.
2. Claims 10-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Dudzik (4444839) has been withdrawn in view of the amendment.
3. Claims 10-13, 15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Waterbury (2002/0182403) has been withdrawn in view of the amendment.
4. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Colon in view of Dudzik has been withdrawn in view of the amendment.

### ***Allowable Subject Matter Withdrawn***

5. Claims 1-9 indicated as being in the last Office Action has been withdrawn in view of the newly discovered art.
6. Claims 16, 18 and 19 objected to in the last Office Action has been withdrawn in view of the newly discovered art.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-9, 16-19 and new claims 20-23 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 16 and 18-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Pemberton (6692594).

Pemberton relates to a first layer of adhesive (23 or 25) which is dispersible in water, a second layer of paper (15) treated with a first release coating between the first layer and the second layer (27) is provided with release coating between the adhesive and the second layer. The presence of the second release coating on the opposite side of the first release coating of the second layer would be inherent when the product is provided in a roll form.

Regarding the preamble phrase, it has not been given any patentable weight because the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description not depending for completeness upon the introductory clause.

9. Claims 17, 20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Milliorn (2004/0247812).

Milliorn relates to a roll of labels for affixing to a surface (abstract). The label comprises a first layer of water dispersible adhesive, a second layer of material such as plastic, foil, etc. which are non-soluble in water, the second layer is adhered to one side of the

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first layer, and a first release coating is provided in contact with and on the other side of the first layer following the formation of a roll (paragraph-[009]).

Regarding the method of recording usage of products (claim 20), Milliorn discloses the steps of providing a label having the structure as discussed above, removing the carrier release sheet, affixing the label to a container and it would inherently remove the label by applying water as the adhesive is water dispersible.

Further, be case the adhesive is water dispersible, the dispersed adhesive particles would not be visible to the human eye.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1- 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milliorn in view of the English Abstract of Japanese:2001-226649.

Milliorn, as discussed above, fails to teach the adhesive layer is a double-sided adhesive. The English Abstact of Japanese: 2001-226649 discloses a water releasable double-sided adhesive tape for adhering articles to a surface and removing it for recycling. The tape has a water-soluble adhesive provided on one side of a non-woven fabric, that may be laminated to a plastic film or a metal foil, and a self adhesive layer on the other side of the fabric. Therefore, it would have been obvious to one having

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ordinary skill in the art to utilize the teaching of the English Abstract of Japanese: 2001-226649 in the invention of Milliorn with the motivation to provide for recycling of labels by dispersing it in water .

### ***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 20 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20, the phrase "said pressure sensitive adhesive" is found to be indefinite for lack of antecedent basis.

Claim 23, as recited, is a duplicate of claim 22.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nasser Ahmad 3/5/06  
Primary Examiner  
Art Unit 1772

N. Ahmad.  
March 5, 2006.